

REMARKS

Claims 1-24 have been rejected by the Examiner. By the present preliminary amendment, claims 1-7, 11, 13, 17-18, 22-24 have been amended. Claims 19, 20, and 21 have been cancelled without prejudice. New claims 25 and 26 are presented for entry. Consequently, upon entry of the present amendment, claims 1-18 and 22-26 will be pending in the present application. Reconsideration of the present patent application is respectfully requested in view of the appended remarks.

CLAIM REJECTIONS

Rejection of claims 1-11 and 13-16 Under 35 U.S.C. 103(a)

The Examiner rejected claims 1-11 and 13-16 under 35 U.S.C. 103(a) as being unpatentable over *Morganstein* (U.S. Patent No. 5,029,196) in view of *Brennan et al.* (U.S. Patent No. 5,329,578). Applicants respectfully request that the Examiner consider the following remarks.

A Prima Facie Case of Obviousness has not been Established

Applicants submit that a *prima facie* case of obviousness has not been established. According to MPEP Section 2142, a *prima facie* case of obviousness must set forth the following elements:

1. The Examiner must show "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings."

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2. The Examiner must show that there must be a “reasonable expectation of success.”

3. The Examiner must show that the cited references “teach or suggest all of the claim limitations.”

- The cited references do not teach or suggest all of the claim elements.

Claim 1, as amended, recites “maintaining a plurality of lists for a telephony subscriber, each of said routing lists being associated with at least one originating source and each routing list comprising a plurality of directory numbers where the subscriber may be accessed, said directory numbers being in an order determined by the subscriber.”

The Examiner alleged that Fig. 1, element 54, which is a “look-up table” that “cross-references call identification numbers to destinations” anticipates the step of “maintaining a plurality of routing lists.” However, *Morganstein*, does not describe a system for “maintaining a plurality of lists for a telephony subscriber,” as recited by amended claim 1. *Morganstein* only maintains *one* (1) list for a subscriber, wherein the list is a “list of telephone numbers associated with potential calling parties.” Col. 2, lines 15 – 25. Each potential calling party is associated with only *one* number, whereas the method of claim 1 associates the originating source with a list comprising a plurality of directory numbers. Thus, *Morganstein* does not teach, suggest, or describe the claimed invention because *Morganstein* only describes a single list, whereas claim 1 recites a *plurality* of lists for each subscriber.

The Examiner also alleged that *Morganstein* Fig. 3, element 82 anticipates “each routing list being associated with at least one originating source.” *Morganstein* only describes one list being maintained for the subscriber, wherein each destination number on the list is associated

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with an originating source. Col. 5, lines 24 – 33. *Morganstein* does not describe a plurality of lists wherein each list is associated with at least one originating source.

The Examiner alleged that *Morganstein* anticipates the step of “selecting a routing list associated with the originating source from the plurality of lists.” Col. 5, lines 24-33 and lines 45-50. *Morganstein* selects *one* number from the *one* list for call routing, based on the calling party’s number, which is entered by the calling party. Col. 7, lines 25-55. *Morganstein* does not describe selecting a list comprising a plurality of directory numbers, from a plurality of lists maintained for a subscriber, as recited by claim 1.

The Examiner admitted that *Morganstein* describes a routing list that comprises only one destination. However, the Examiner alleged that *Brennan* describes a list comprising a plurality of directory numbers and directing a call sequentially to the directory numbers on the routing list. However, *Brennan* does not describe the use of a plurality of lists, and there is no suggestion that a plurality of lists may be maintained for a particular subscriber.

- There is no suggestion or motivation to combine the teachings of *Morganstein* and *Brennan*

Applicants, in addition to the above remarks, further claim that there is no “suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings,” as required by MPEP 2142. There is no suggestion or indication that the teachings of *Brennan* can be combined with any of the teachings of *Morganstein* to derive the present invention.

The present invention enables a subscriber to create a plurality of routing lists that correspond to a plurality of originating sources. The subscriber specifies the numbers that appear on each list, and the order in which the calls are routed to each number on the list. This enables the subscriber to decide what treatment to give each call. Each originating source may be associated with a different routing list. Additionally, once a routing list associated with the originating source has been selected, having a plurality of routing numbers on each list allows for an originating source to have a greater possibility of accessing the subscriber. The present invention thus provides for maximum flexibility in not only allowing subscribers to dispose of calls in a manner preferred by the subscriber, but also allowing the subscriber to determine the order of the routing of the call.

Morganstein is directed to allowing a subscriber (the called party) of a telephone service to direct calls to any one of a list of numbers where the subscriber can be reached. These calls are directed to selected numbers based on the identification of the calling line, or the geography of the originating call. Col. 2, lines 15-19; Col. 2, lines 50-55. However, *Morganstein* does not recognize the problem that results if the call is directed to the subscriber at a number designated by the subscriber, but the subscriber does not answer. Nor does *Morganstein* suggest a solution to this problem.

Brennan aspires to provide subscribers with incoming call management. Col. 1, lines 32-36. *Brennan* describes a "hunting feature" that allows a subscriber to list **up to three** locations by which the system is to attempt to contact him. Col. 10, lines 7-23. Thus, *Brennan* only describes or suggests one list for call routing of *all* incoming calls. *Brennan* also provides for features in which the *caller*, or originating source, may choose to route the call. Col. 12, lines

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25-29. *Brennan* does not, however, suggest that each call is routed differently based on the identity or origin of the originating source. Furthermore, the failure of *Brennan* to describe a plurality of lists limits the subscriber's control as to the disposition calls directed to the subscriber.

Consequently, *Morganstein* and *Brennan* implicitly teach away from each other. First, neither one uses or suggests the use of a plurality of lists, or the advantages of having a plurality of lists. *Morganstein* has only one list, and *Brennan*'s hunt feature suggests one list comprising of up to three locations. *Morganstein* routes each call *differently*, based on the identity of the originating source, to *one* number on the list. Conversely, *Brennan*'s hunt feature routes all incoming calls *similarly*, each call being routed to a *plurality* (up to three) of numbers on the list. The fundamentally different way in which *Morganstein* and *Brennan* handle call routing implicitly teaches away from the combination of the two references.

Because both *Morganstein* and *Brennan* fail to recognize the problems that are addressed by the present invention, and because there is no suggestion in the references that any of the features of *Morganstein* and *Brennan* can be combined, Applicants respectfully submit that there is no *prima facie* case of obviousness.

Thus, Applicants respectfully submit that the preceding amendments and the foregoing remarks overcome the Examiner's rejection of claim 1 based on obviousness.

Because claims 2-11 and 13-16 include the aforementioned patentable features, Applicants respectfully request that the Examiner's rejections of claims 2-11 and 13-16 be withdrawn. In addition, Applicants respectfully submit that claims 17-24 (including cancelled

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claims 19-21) also include the aforementioned patentable features, and thus should be allowed by the Examiner.

***Morganstein* Fails to Disclose All Claim Limitations of Claims 8-10**

Regarding claims 8- 10, the Examiner stated that *Morganstein* teaches that the method wherein the selecting a routing list step further comprises the step of selecting the routing list from a group of routing lists identified for the originating party based on the day of the week or/and the time of the day the communication is received (col. 13, lines 15-18). This rejection is respectfully traversed.

The Examiner's citation, *Morganstein* col. 13, lines 15-18, reads "Indeed, the telephone user or programmer of the call processor can preselect destinations for various calling parties to optimize the user's time and efficiency." *Morganstein* does not, however, teach the ability to route calls to the called party based the time of the week, time of the day, in addition to the identity of the originating party, or both, as recited by claims 8 – 10. Thus, Applicants respectfully request that the Examiner's rejection of claims 8 – 10 be withdrawn.

Rejection of claim 12 under 35 U.S.C. 103(a)

The Examiner rejected claim 12 under 35 U.S.C. 103(a) as being unpatentable over *Morganstein* (U.S. Patent No. 5,029,196) in view of *Brennan et al.* (U.S. Patent No. 5,329,578), and further in view of *Eisdorfer et al.* (U.S. Patent No. 5,706,339).

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Applicants submit that *Eisdorfer* does not teach or suggest a plurality of routing lists for a subscriber. Nor does *Eisdorfer* suggest that its teachings can be combined with any of the other references.

Eisdorfer focuses on routing numbers to a number of locations. *Eisdorfer* describes that a subscriber does not have to be at one particular number in order to receive all of the subscriber's calls (col. 1, lines 11-30). *Eisdorfer* describes that a calling is routed through a sequence of numbers where the subscriber can be reached (col. 1, lines 30-45). *Eisdorfer* further describes that if a subscriber calls another number that belongs to the subscriber (for example, calling the subscriber's house from the subscriber's cellular phone), that the subscriber's originating call does not get routed to the calling number he is dialing from (the cellular phone) (col. 1, line 45– col.2 line 4). Finally, *Eisdorfer* avoids routing the caller to numbers on the routing list that are disconnected.

Eisdorfer does not disclose the selection of a routing list based on the originating source of the call. Similar to *Brennan*, *Eisdorfer* discloses the *same* routing of *all* calls through a *plurality of numbers* on a routing list, avoiding disconnected numbers and the number the caller is dialing from. *Morganstein*, on the other hand, describes the *different* routing of *each* call based on the identity of the caller to *one* number associated with the originating call. The teachings of *Morganstein* and *Eisdorfer* (and *Brennan*) are fundamentally different such that they implicitly teach away from each other. Thus, Applicants respectfully submit that there is no case of obviousness, as there is no suggestion that the features of *Brennan* and *Eisdorfer* can be combined with *Morganstein* to derive the present invention of this application.

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Because claim 12 includes the patentable features as recited in claim 1, claim 5, and claim 11, Applicants also respectfully submit that the Examiner's rejection of claim 12 should be withdrawn.

NEW CLAIMS

New claims 25 and 26 are dependant claims directed to a feature of the present invention that allows a routing list to be selected from a plurality of routing lists based on the area code and the exchange of the originating line. These claims are supported in the specification on page 16, lines 4-14.

The preceding arguments address only the arguments in the Official Action, and therefore may not address patentable aspects of the invention that were not addressed by the Examiner in the Official Action. The claims may include other elements that are not shown, taught, or suggested by the cited references. Accordingly, Applicants advance the preceding arguments in favor of patentability without prejudice to other bases of patentability.


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CONCLUSION

Applicants thank the Examiner for the Examiner's consideration of this preliminary amendment and these remarks. Applicants submit that the pending claims are patentable over the art cited and respectfully request allowance of these claims. If the Examiner believes that there are any issues that can be resolved by a telephone conference, an Examiner's amendment, or an in-person interview, please call Brenda Ozaki Holmes at (404) 949-2487.

Respectfully submitted,

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